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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
03-380-D

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on _____

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name _____

Application Number
09/978,170

Filed
October 15, 2001

First Named Inventor
Scott A. Rosenberg

Art Unit
3688

Examiner
Jean D. Janvier

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/David L. Ciesielski/

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

David L. Ciesielski

Typed or printed name

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attorney or agent of record.

Registration number 57,432

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

November 6, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No. 03-380-D)**

In re the Application of:)	
)	
Rosenberg et al.)	Examiner: Jean D. Janvier
)	
Serial No.: 09/978,170)	Confirmation No.: 3931
)	
Filed: October 15, 2001)	Art Unit: 3688
)	
For: Method and System for Pause Ads)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the office action mailed August 6, 2008 (hereinafter "the final rejection") and the advisory action mailed October 8, 2008 because of clear errors made in rejecting the claims pending in the instant application.

First, Applicant submits that the Examiner has not clearly articulated the rejection of any of the pending claims. On page 2 of the final rejection, the Examiner indicated the statutory grounds for rejecting the pending claims. In particular, the Examiner stated, "Claims 1-2, 5-11, 13-18, 20, 22-25 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,740,549A." However, on page 7, second paragraph, of the final rejection, the Examiner referred to independent claims 1 and 20, as well as to claims 22-24, and stated, "Reilly does not expressly teach **pressing a pause key**, displayed on a screen (video replay system) to thereby trigger the pause mode." (Emphasis original). Reilly is USP 5,740,549A.

To make up for the deficiency of Reilly, the Examiner classified the third and fourth paragraphs on page 7 of the final rejection as "Official Notice." Thereafter, the Examiner

indicated it would have been obvious to an ordinary skilled artisan, implementing Reilly's system, at the time of the invention to incorporate the above disclosure (i.e., the Official Notice on page 7 of the final rejection) into Reilly's system. (See, the final rejection, page 8, second paragraph). Then, while discussing claims 25-28, the Examiner referred to text on pages 9 and 10 of the final rejection as "Official Notice." Since the Examiner appears to have relied on Reilly and official notice to reject the claims and since the Examiner, when listing the statutory grounds for rejecting the pending claims, merely indicated the claims were rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,740,549A (Reilly), Applicant submits that the Examiner has not clearly articulated the rejection of the pending claims.

Furthermore, with respect to independent claims 1 and 20, even if the Examiner meant to reject these claims under 35 U.S.C. § 103(a) as being unpatentable over Reilly and the text recited on page 7, third and fourth paragraphs of the final rejection, Applicant submits that the Examiner has omitted at least one essential element needed for a *prima facie* rejection under 35 U.S.C. § 103(a). The at least one essential element is (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, and (ii) upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, as recited in claims 1 and 20.

As far as Applicant can tell, the Examiner argued that a predefined idleness criteria (e.g., the failure to receive any input for a period of five minutes), as disclosed by Reilly, amounts to the "pause mode" recited in claims 1 and 20. (See, e.g., the final rejection, (i) page 3, first paragraph, line 5, (ii) page 3, second paragraph, lines 4-5, (iii) page 3, third paragraph, line 3 to

page 4, first paragraph, line 3 (iv), page 5, first paragraph, lines 4, and 6-8, and (v) page 6, second paragraph, lines 1-3). Thereafter, in rejecting claims 1 and 20, the Examiner stated “Reilly does not expressly teach **pressing a pause key**, displayed on a screen (video replay system) to thereby trigger the pause mode.” Even so, the limitation of claims 1 and 20 is not recited in this manner. Instead claims 1 and 20 recite, “while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key.”

To make up for the deficiency of Reilly, the official notice taken by the Examiner on page 7 of the final rejection provides, *inter alia*, it is common practice in the art to display a button or icon (key), representing a stored content or software installed in the memory of a system or computing device, on a user’s screen (desktop or video replay system) and wherein actuating, pressing, activating or clicking the button or icon (pause key) causes the stored content to be displayed on the screen or the task related to the installed software to be executed. (See, the final rejection, page 7, third paragraph). However, even if, for the sake of argument, it is assumed that this portion of official notice amounts to “while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key,” Applicant submits that modifying Reilly with this portion of the official notice does not lead to the invention recited in claims 1 and 20.

According to Reilly, generally, whenever the system detects *a lack of user inputs via either a keyboard or pointer device* (e.g., a mouse or trackball) for a user configurable or otherwise specified length of time (e.g., 5 minutes), the screen saver procedures of the present invention begin the display of news items and advertisements from the local information database. (See, Reilly, col. 11, lines 43-49, emphasis added). Applicant submits that actuating,

pressing, activating or clicking the button or icon (pause key), as provided for by the official notice, amounts to a user input that if detected by the system during the user configurable length of time would prevent the system from detecting *a lack of user inputs via either a keyboard or pointer device*, and thus would prevent the screen saver procedures from displaying the news items and advertisements until such time that the user configurable length of time has passed after actuating, pressing, activating or clicking the button or icon (pause key).

Additionally, Reilly discloses (i) execution of the screen saver procedure, like other screen savers, is terminated and the subscriber's computer's display is returned to whatever was being displayed before the screen saver was executed, *upon detection of certain types of user input*, and (ii) in the preferred embodiment, the user can use the profiler to select one of at least two exit modes. In a first mode, the screen saver procedure is terminated by *hitting any key on the subscriber computer's user interface keyboard* or by moving the user interface's mouse or trackball. In a second mode, the screen saver procedure is terminated by *hitting any key on the subscriber computer's user interface keyboard*, but movement of the mouse or trackball does not cause the screen saver procedure to terminate. (See, Reilly, col. 12, line 57 to col. 13, line 3, emphasis added). Applicant submits that actuating, pressing, activating or clicking the button or icon (pause key), as provided for by the official notice, amounts to a user input that would terminate the screen saver procedures of Reilly if the screen saver procedures were being executed when the button or icon (pause key) is actuated, pressed, activated or clicked.

For at least these reasons, as well as the reasons listed in Applicant's response filed September 15, 2008 at page 7, line 14 to page 10, line 18, Applicant submits that the combination of Reilly and the official notice on page 7 of the final rejection do not reasonably lead to (i) while the user selected program content is being displayed on the display of the video

replay system, entering a pause mode in response to a user action that comprises pressing a pause key, and (ii) upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, as recited in claims 1 and 20.

Additionally, as far as Applicant can tell, in rejecting claims 1, 2, 5-11, 13-18, 20, 22-24, 26, and 27, it appears that the Examiner recited or paraphrased portions of Reilly and inserted portions of some of the claims terms of claims 1, 2, 5-11, 13-18, 20, 22-24, 26, and 27 in parenthesis when reciting or paraphrasing the portions of Reilly. (See, the final rejection, page 2, last paragraph to page 7, first paragraph). Applicant submits that this portion of the final rejection does not clearly articulate the rejection of any of claims 1, 2, 5-11, 13-18, 20, 22-24, 26, and 27.

In conclusion, Applicant submits that the Examiner clearly committed errors in rejecting independent claims 1 and 20 under 35 U.S.C. § 103 and that claims 1 and 20 are allowable over Reilly, or in the alternative, over Reilly in view of official notice recited in the final rejection on page 7, third and fourth paragraphs. Additionally, Applicant submits that all of the pending dependent claims are allowable for at least the reason that each of the dependent claims depends from one of the allowable independent claims. Accordingly, Applicant respectfully requests the panel to issue a decision that the instant application is allowed on the existing claims and that prosecution remains closed.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: October 27, 2008

By: /David L. Ciesielski/
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